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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael Gauselmann
Serial No: 09/491,779 Art Unit: 3711
Filing Date: January 26, 2000
Title: METHOD FOR OPERATING A COIN ACTUATED
ENTERTAINMENT AUTOMAT
Examiner: David W. Duffy

February 20, 2009

Attorney's Docket No.: ADP231TO

TRANSMITTAL LETTER

Commissioner for Patents
P.O. BOX 1450
Alexandria, Virginia 22313-1450

SIR:

Transmitted herewith for filing is:

**<X> PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181 (11 pages)**

<X> The Commissioner is hereby authorized to charge any fees under 37 CFR. 1.16, 1.17 and 1.18 or any additional fees which may be required during the entire pendency of the application, or credit any overpayment, to Acct. No.11-0224. A duplicate copy of this sheet is enclosed. If and only if(r) account funds should be insufficient, immediately contact our associate, Lisa Zumwalt, at (703)415-0579, who will pay immediately to avoid deprivation of rights.

< > Please charge my Deposit Account No.11-0224 in the amount of \$_____. A duplicate copy of this sheet is enclosed.

A signature or signatures required for the above recited document(s) is (are) provided here-below. Such signature(s) also provide(s) ratification for any required signature appearing to be defective in the above-recited document(s).

Horst M Kasper

Horst M. Kasper, 13 Forest Drive, Warren, N.J. 07059
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CERTIFICATE OF MAILING under 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Hon. Commissioner for Patents, Alexandria VA, 22313 on 20 FEB 2009 Signature: *[Signature]*
Date: 20 FEB 2009

%ADP231TO-FEBRUARY 20, 2009/hk



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**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181**

Hon. Commissioner of Patents and Trademarks
P.O. Box 1450, Alexandria, VA 22313

SIR:

This is a petition to withdraw a holding of abandonment under 37 CFR 1.181 and is in response to a Notice of Abandonment in the above captioned matter mailed on February 6, 2009.

The Notice of Abandonment reads as follows:

The application is abandoned in view of:

1. Applicant's failure to timely file a proper reply to the Office

Action letter mailed on 18 June 2008

(c) A reply was received on 19 November 2008 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection.

See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below)

7. The reason(s) below:

Applicant has filed numerous non-compliant amendments (04/04/2008, 04/30/2008, 07/21/2008, and 11/19/2008) without correctly marking changes and status of the claims. See claims 1, 3 and 86 of the 11/19/2008 amendment.

The petitioner apologizes fully for any non-compliant amendment submitted without correctly marking changes and status of the claims.

The amendment 11/19/2008 changed a status or gave a new status relative to the amendment of 09/13/2007 to a total of 82 claims as follows:

3 claims went from “(currently amended)” in the amendment 09/13/2007 to “(previously presented)” in the amendment 11/19/2008;

1 claim went from “(currently amended)” in the amendment 09/13/2007 to “(currently amended)” in the amendment 11/19/2008;

2 claims went from “(currently amended)” in the amendment 09/13/2007 to “(cancelled)” in the amendment 11/19/2008;

8 claims went from “(previously presented)” in the amendment 09/13/2007 to “(cancelled)” in the amendment 11/19/2008;

13 claims went from “(new)” in the amendment 09/13/2007 to “(cancelled)” in the amendment 11/19/2008;

33 claims went from “(new)” in the amendment 09/13/2007 to “(previously presented)” in the amendment 11/19/2008; and

22 claims were “(new)” in the amendment 11/19/2008.

Petitioner respectfully submits that the 82 changes in status or new statuses presented in the amendment 11/19/2008 are all

bona fide responses to the Office Communication 10/16/2008. In addition bona fide changes were made for example in claims 7 to 9.

The Notice of Abandonment points to claims 1, 3, and 86 of the 11/19/2008 amendment:

Claim 1, line 6 on 11/19/2008 was presented as:

“symbol combination comprises several symbols and wherein, upon”

and claim 1, line 6 on 02/13/2009 was corrected to:

“symbol combination comprises several symbols and wherein, upon”.

Claim 3, line 16 on 11/19/2008 was presented as:

“actualize the intermediate state;”

and claim 3, line 16 on 02/13/2009 was corrected to:

“actualizing an intermediate state;”.

Claim 86, line 19 (last line) on 11/19/2008 was presented as:

“automats (1). [[:]]”

and claim 86, line 19 (last line) on 02/13/2009 was corrected to:

“automats (1).”.

It is respectfully submitted that the corrections performed on 02/13/2009 can be classified as an elimination of informalities of a typographical or clerical nature. The petitioner believes that the informalities, which were present in claims 1, 3 and 86 of the amendment 11/19/2008, in no case prevented or interfered with a potential evaluation of claims 1, 3 or 86 on the merits.

Section 37 CFR 1.111(b) with respect to an Office Action reads in part as follows:

“If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action.”.

Petitioner respectfully submits that such a request that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated could have been made by the petitioner in connection with anyone of the non-compliant amendments (04/04/2008, 04/30/2008, 07/21/2008, and

11/19/2008). The three informalities found in the amendment 11/19/2008 can certainly be considered to represent objections or requirements as to form not necessary to further consideration of the claims as referred to in 37 CFR 1.111(b).

If appropriate, the petitioner respectfully requests nunc pro tunc with the amendment 11/19/2008 in accordance with 37 CFR 1.111 (b) that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated.

The Notice of Abandonment concedes that a reply was received on 19 November 2008 but alleges that it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below)

Petitioner believes that the Office Communication of 10/16/2008 was not a “rejection” of petitioner’s claims although alleged to be a rejection in the Notice of Abandonment, but was in fact a request to

restate the current claims marked up relative to the amendment 09/13/2007. If the Office Communication of 10/16/2008 was no rejection of the claims of the petitioner as the petitioner believes, then the reasoning of the Notice of Abandonment that petitioner's amendment of 11/19/2008 would not meet the requirements placed on an attempt to reply to a non-final "rejection" would not concern the reply 11/19/2008 to an Office Communication 10/16/2008 not containing a rejection.

Petitioner urges that the reply of 11/19/2008 was a proper reply or at least a bona fide attempt at a proper reply to the Office Communication of 10/16/2008.

"bona fide" is defined as "in good faith; without fraud" in WEBSTER'S NEW UNIVERSAL UNABRIDGED DICTIONARY, Publisher Barnes and Noble Books, 1994. Petitioner insists that the amendment 11/19/2008 was made in good faith and without fraud. The status changes and/or new statuses of 82 claims are deemed to

demonstrate the good faith of the petitioner throughout the amendment of 11/19/2008.

Claims 2, 4 through 9, 13 through 18, 24, 27 through 45, 49, 54, 60 through 85 and 87 through 93 of the petitioner's amendment 11/19/2008 were not cited in the Notice of Abandonment of February 6, 2009 and therefore these 68 claims constitute a clearly bona fide part throughout the amendment 11/19/2008.

The petitioner respectfully submits that where the overwhelming majority (68) of claims in an amendment is bona fide compared with a small minority (3) of claims in the amendment containing informalities that then the amendment as a whole is also bona fide.

Petitioner further submits that three informalities of a typographical or clerical nature in an amendment of 94 pages are not capable to render this amendment not bona fide or in bad faith or with fraud.

The amendment 11/19/2008 was in response to the Office Communication of October 16, 2008, which for the first time required the petitioner to mark all changes relative to the set of claims filed 9/13/2007. There were no Office Communications prior to the Office Communication of 10/16/2008 requesting an amendment, where the Status would be referring back to the amendment 09/13/2007. The request of the Office Communication of 10/16/2008 was in the form of a general instruction and without a pointing out of individual errors needing corrections and/or correction proposals.

The holding in the Notice of Abandonment of February 6, 2009 that the amendment 11/19/2008 is not a bona fide attempt at a proper reply is deemed to be administrative arbitrariness in view of the length of the amendment 11/19/2008 and the changed or new status of 82 claims plus additional claim changes. The petitioner attempted in good faith to meet on 94 pages the requirements of the Office communication of 10/16/2008. The task issued by the Office Communication of 10/16/2008

was performed fully by the petitioner with the exception of three informalities.

The MPEP Section 711.03(c) reads as follows:

“When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.”

It is respectfully submitted that the reply of November 19, 2008 by the petitioner is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office Communication of October 16, 2008, but consideration of three informalities or compliance with the requirement to remove all errors has been inadvertently omitted. Petitioner's amendment of 11/19/2008 is clearly directed to respond in good faith to the Office Communication of 10/16/2008.

It is submitted that the Notice of Abandonment of February 6, 2009 appears to be very harsh on the petitioner by having the application

abandoned in view of three informalities found by the Examiner within an extensive and bona fide amendment of 11/19/2008.

It is urged that the Holding of Abandonment of February 6, 2009 appears to have been issued in error and should be withdrawn.

A corrected amendment for resolving the informalities in claims 1, 3 and 86 was filed on February 13, 2009. Entry of the corrected amendment is respectfully requested.

Respectfully submitted,

Michael Gauselmann

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